



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,197	05/23/2000	Kia Silverbrook	NPA001US	9186

24011 7590 06/22/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

SNAPP, SANDRA S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

20

Office Action Summary

Application No.

09/575,197

Applicant(s)

SILVERBROOK ET AL.

Examiner

Sandra Snapp

Art Unit

3624

MMJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) 19 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 and 20-53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

Currently, claims 1-18 and 20-53 are pending in the application, claim 19 has been cancelled. This Office Action is in response to the Amendment filed 8-7-03.

Specification

The disclosure remains objected to because the information identifying the parent application should be updated to reflect **the status of the pending applications as well as filing dates for each application**. A heading should be added prior to this information. See MPEP section 608.01(a). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The rejection of claims 4, 8-20, 22, 24-28, 33-35, 41, 43-45 and 47 under 35 U.S.C. 112, second paragraph, as being indefinite is herein withdrawn. The Applicant's Amendment dated 08-07-03 cancelled all questionable subject matter thereby successfully addressing all the issues raised in the previous office action with regard to this rejection.

Claim Objections

Claim 1 is objected to because the phrase "the sensing device the indicating data" in line 9 is confusing. Should the phrase "the sensing device" be deleted?

Claim Rejections - 35 USC § 101

The rejection of claims 1-28, 33-35 and 41-47 under 35 U.S.C. 101 is herein withdrawn since the Applicant has successfully overcome the rejections with the Amendment submitted on 08-07-03 by canceling any claim language wherein a person was being claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 8-14, 17-18, 21, 23-24, 26, 28-40, 42-44, 46 and 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent and further in view of the Mallicoat patent (5248856).

The Perazza patent discloses a method, associated computer system, of enabling payment of bills, including the steps of:

Providing a bill containing human-readable information relating to a requested payment and coded data indicative of an identity of the bill and of at least one reference point of the bill, receiving indicating data from a sensing device the data indicative of the identity of the bill and at least one of a position and a movement of the sensing device relative to the bill, the sensing device, when placed in an operative position relative to the bill, sensing at least some of the coded data and generating the indicating data using at least some of the sensed coded data (P-col. 16, lines 29-54 and col. 11, lines 18-22), identifying at least one parameter relating to the

Art Unit: 3624

payment (P-col. 16, lines 24-54), a bill including encoded data (P-col. 15, lines 30-42) and a computer for receiving data (P-col. 5, lines 15-24)(claims 1, 4, 5, 29, 31, 32, 33, 34 and 35);

The parameter relating to the requested payment is associated with at least one zone of the bill and in which the method includes identifying, in the computer and from the zone indicated by the position of the sensing device as indicated by the indicating data (P-col. 16, lines 29-48) (claims 2 and 30);

The coded data is indicative of at least one parameter of the requested payment, the indicating data includes parameter information indicative of the at least one parameter, the sensing device having determined the parameter information (P-col. 10, lines 29-48) (claim 6);

The parameter is an action parameter and the method effecting an operation in respect of the action parameter (P-col. 16, lines 28-48) (claim 8);

The action parameter is selected from the group consisting: requesting that payment be made, specifying a payment amount or resetting the bill to an original state (P-col. 16, lines 28-48) (claims 9 and 37);

The parameter is an option parameter, the method identifying that a hand-written mark has been entered by the sensing device and effecting an operation associated with the option parameter (P-col. 16, lines 55-63) (claim 10);

The option parameter is associated with at least one of a cardholder name, payment method or credit card type (P-col. 16, lines 28-48) (claims 11 and 38);

The parameter is a text parameter and the method identifying that handwritten text data has been entered by the sensing device and effecting an operation associated with the text parameter (P-col. 16, lines 55-63) (claim 12);

Converting the handwritten text data to computer text (P-col. 16, lines 55-63), using an online handwriting recognition program (P-col. 16, lines 55-63) (claim 13);

The text parameter is associated with at least one of a cardholder name, an amount payed or a card expiry date (P-col. 16, lines 28-63) (claims 14 and 39);

The authorization parameter is associated with payment authorization (P-col. 16, lines 28-63) (claims 17 and 40);

Receiving a request from a user to print the bill on demand (P-col. 6, lines 53-65) (claim 18);

Retaining a retrievable record of each bill generated, each of the generated bills being retrievable using its identity as contained in the coded data (P-col. 6, lines 53-65) (claim 21);

Providing required information relating to the requested payment in the bill to eliminate the need for a separate display (P-col. 6, lines 53-65) (claim 24);

Providing the bill is done by sending the bill by mail (P-col. 3, lines 62-66) (claim 26);

Causing a printer to print a payment receipt after the payment has been completed (P-col. 6, lines 53-65) (claim 27);

The payment receipt comprises coded data indicative of the identity of the receipt (P-col. 6, lines 53-65) (claim 28);

The at least one parameter is selected from the group comprising an action parameter of the requested payment, an option parameter of the requested payment, a text parameter of the

Art Unit: 3624

requested payment, or an authorization parameter of the requested payment (P-col. 16, lines 28-48) (claim 36);

The bill is printed on a surface of a surface defining means and in which the system includes a printer for printing the bill on demand (P-col. 6, lines 53-65) (claim 43);

The printer is configured to print the coded data at the same time as the bill or payment receipt (P-col. 6, lines 53-65) (claim 44); and

A database for keeping retrievable records of each bill generated, each bill being retrievable by using its identity as included in the coded data (P-col. 7, lines 9-23) (claim 46); a method for supporting a user in performing online bill paying using a printed form containing information relating to a bill paying transaction (P-col. 16, lines 29-48), and coded data indicative of at least one parameter of the bill paying transaction (P-col. 16, lines 29-48), an identity of the user (P-col. 16, lines 29-48), an identity of the form (P-col. 16, lines 29-48), the method including receiving indicating data from a sensing device, the indicating data being indicative of the at least one parameter and of movement of the sensing device relative to the form (P-col. 16, lines 29-48 and col. 11, lines 18-22), the sensing device having generated the indicating data by sensing at least some of the coded data when the sensing device was moved relative to the form (P-col. 16, lines 29-54 and col. 11, lines 18-22), and interpreting the movement of the sensing device as it relates to the one parameter (P-col. 16, lines 24-54) (claims 49, 50, 51, 52 and 53).

The Perazza patent discloses all the elements of the claimed invention except for the information and coded data having been printed simultaneously (claims 1, 4, 5, 29, 31, 32, 33,

Art Unit: 3624

34, 35, 49, 50, 51, 52 and 53). The information and coded data being printed simultaneously is merely non-functional descriptive material and are not functionally involved in the steps recited. The steps of the method would be performed the same regardless of the information and coded data being printed simultaneously. Thus, the descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Claims 3, 7 23, 32 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent, further in view of the Mallicoat et al. patent (US 5,248,856).

The Perazza patent lacks receiving data regarding at least one of movement and the position of the sensing device, and identifying, from at least one of the movement and the position being at least partially within the at least one zone, the at least one parameter of the requested payment (claims 3, 7 and 32). The Mallicoat patent teaches receiving data regarding at least one of movement and the position of the sensing device, and identifying, from at least one of the movement and the position being at least partially within the at least one zone, the at least one parameter of the requested payment (M- col. 7, lines 48-56) (claims 3, 7 and 32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to include the teachings of the Mallicoat patent so as to provide a more accurate and informative reading from the bill.

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the sensing device containing an identification means which imparts a unique identity to the sensing device and identifies it as belonging to a particular person and in which the method

Art Unit: 3624

includes monitoring, the identity (claims 23 and 42). The Mallicoat patent teaches the sensing device containing an identification means which imparts a unique identity to the sensing device and identifies it as belonging to a particular person and in which the method includes monitoring, the identity (M-col. 6, line 66 through col. 7, line 9) (claims 23 and 42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to include the teachings of the Mallicoat patent so as to provide a more accurate and informative reading from the bill.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent, further in view of the Beatson et al. patent (US 5,892,824).

The Perazza patent lacks a system that identifies that a hand-written signature has been entered by means of the sensing device and effecting an operation associated with the authorization parameter (claim 15), and that the signature is that of a particular person (claim 16). The Beatson patent teaches a system that identifies a hand-written signature (B-col. 8, lines 41-52) (claim 15) and verifies that the signature is that of a particular person (B-col. 8, lines 41-52) (claim 16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza system to include the teachings of the Beatson patent so as to make the system more user friendly, fast, efficient and secure.

Claims 20, 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent and further in view of the PCT application WO 99/50787 (XEROX).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the data is invisible (claims 20 and 45) and the sensing device having a marking nib (claim 41). The XEROX reference teaches the data being invisible (page 8, lines 23-25) and the sensing device having a marking nib (505, page 14, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have invisible data so as to interfere with other visible markings on the bill and to have a sensing device with a nib so that should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent and further in view of the Story patent (5,673,430).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the bill using a mixture of multicast and pointcast communication protocols (claim 22). The Story patent teaches the use of multicast and pointcast communication protocols (col. 3, lines 14-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to use multicast and pointcast communication protocols so as to reduce operating costs.

Claims 25 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent and further in view of the Japanese Patent Abstract 10194562 A.

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the binding of a multipage bill (claims 25 and 47). The Japanese patent abstract reference

Art Unit: 3624

teaches the binding of multiple pages of the bill (Solution portion of Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have a means of binding a bill having multiple pages so that the various pages will remain together and reduce the opportunity for them to become separated.

Double Patenting

Claims 1-21, 25 and 29-47 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 23-24, 28-40 and 42-48 of copending Application No. 09/575,181.

The previous rejections based on double patenting are herein withdrawn in view of the Terminal Disclaimer filed on 8-7-3.

Response to Arguments

Applicant's arguments filed in the Amendment of 8-7-3 have been fully considered but are deemed moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Bennett et al., Martin, Murakami et al., Cooreman, Enokido et al., Tsunekuni et al., Miyamori et al., Mallicoat, Wilson et al., Glenn, Liou, Kofune et al. and Holtzman patents are all directed to various types of sensing devices.

Art Unit: 3624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

Sandra Snapp
SANDRA S. SNAPP
PATENT EXAMINER
GROUP 3600